

REMARKS

Claims 1-7, 9-12, 14-20, and 22 remain. Claims 1, 2, 9, 11, and 19 are amended. No new matter has been added. Applicant respectfully requests favorable reconsideration and allowance in light of the remarks contained herein.

I. Rejection Irregularities

In the previous Final Office Action while making a rejection under 35 U.S.C. §112, Examiner took the position that it was unclear what was taking place in “parallel” in claim 1. Examiner stated that there were two viable assumptions as to what the claim could mean. While Applicant disagreed with Examiner’s position regarding the clarity of the claim, Applicant amended the claim. Applicant further indicated to Examiner the type of parallel process being claimed because Examiner’s proposed assumptions were incorrect. This explanation was acknowledged by Examiner in the present Office Action. *See* Office Action pg. 3. Examiner continues to assert that there are flaws in the language of claim 1. However, instead of examining the content of the limitations, as explained by Applicant, on their merits (limitations of which Examiner was clearly made aware), Examiner gave no weight to the amendments and stated that the amendments are interpreted “as not further limiting.” *See* Office Action pg 4. Applicant respectfully submits that this action was improper. *See* MPEP 2143.03(I) (stating that a claim limitation which is considered indefinite cannot be disregarded).

Applicant notes that:

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. MPEP 706.07(a).

Therefore, in the event that Examiner rejects claim 1 based on the correct interpretation of parallel processing for claim 1, Applicant notes that such a rejection can not properly be made final. Applicant further notes that similar errors were made in the examination of claims 4, 11, and 20.

II. Claim Rejections 35 U.S.C. § 112

Claims 1-7, 9-12, 14-20, and 22 are rejected under 35 U.S.C. § 112 second paragraph, as being indefinite. More specifically, the Office Action takes issue with Claims 1 and 11 for appearing to have three separate types of individual mail pieces. The Office Action also takes issue with this language being unclear as to how many mail pieces are being discussed on the role of the individual mail pieces at various points throughout the system and their relation to the claimed process. Further, the Office Action cites lack of antecedent basis for “the individual mail piece being physically created and processed” in claims 1 and 11.

Applicant respectfully disagrees with the reasoning set forth in Office Action. Claim 1 clearly states that the high-speed processing system transfers “mail pieces.” Postage is calculated for “each individual mail piece,” which clearly refers to the above-recited mail pieces. The postage computing device is operable to generate indicia for “an individual mail piece” (which clearly refers to one of the above-recited “mail pieces”) in parallel with “the individual mail piece” being physically created and processed. The recitation “the individual mail piece” clearly refers back to the recitation of “an individual mail piece.” Hence the previous language was proper. Applicant notes that the analysis for claim 11 is similar.

Despite the fact that the claim language was sufficiently clear, Applicant has again amended the claims to assist the Examiner. These amendments are made for the sake of advancing prosecution only, and no change in the claim scope is intended. In the event that Examiner maintains the rejection, Applicant respectfully solicits Examiner’s suggestion as to what language Examiner believes acceptable based upon Applicant’s repeated explanations as to what the claim language recites.

The Office Action rejects claim 19 as being unclear as to whether the “without weighing” recitation actually refers to the weights of the documents alone or both the documents and the mail piece. Applicant notes that the claim recites “without weighing the individual mail piece” and that the documents are “included in” the mail piece. Hence, the mail piece includes the documents.

Additionally, the Office Action states that the lack of punctuation in claim 19 further makes the plain meaning of the limitation unclear. While Applicant disagrees that this informality creates any ambiguity which arises to the level of causing a §112 rejection, claim 19 has been amended clarify its language.

As a result, Applicant submits that the claims are in proper order. Therefore, Applicant respectfully requests that the rejections 35 U.S.C. § 112, second paragraph, be withdrawn.

III. Claim Rejections 35 U.S.C. § 103

A. Rejection over *Freeman* in view of *Leon*

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Freeman et al. (U.S. Pat. 4,742,878, hereinafter “*Freeman*”) in view of Leon (U.S. Pat. Pub. 2001/0042052, hereinafter “*Leon*”). To establish prima facie obviousness of a claimed invention, all the claim limitations must be shown by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combinations fail to teach multiple claim limitations as asserted by the Examiner, Applicant respectfully submits that the present rejections is improper.

Claim 1 recites “said postage computing device operable to use said calculated postage value to generate an information based postage indicia for a mail piece of said plurality of mail pieces in parallel with the mail piece of said plurality of mail pieces being physically created and processed by at least one mail processing component.” As an initial matter, the Office Action’s failure to give proper weight to this limitation, as outlined above, had an adverse effect its substantive rejections. *Freeman* teaches a device that feeds a mail piece to a weighing module, after weighing the mail piece, the postage meter is set, the mail piece is then transferred through the metering system. (see *Freeman* Abstract). It is clear that everything in this process is done in serial. Accordingly, *Freeman* does not teach a device operable to generate information based postage indicia for an individual mail piece in parallel with the mail piece being physically processed.

Additionally, in Applicant’s previous response claim 1 was amended to recite that the postage based indicia is being generated in parallel with the mail piece being *created and*

processed. This is clearly not taught by *Freeman*. Examiner did not provide any reasoning in the response to arguments section of the current Office Action as to where this is taught in the art. Examiner cites *Freeman* col. 9 lines 33-40, as teaching this limitation (the same portions cited before the amendment). However, there is no discussion in the cited portions relating to the creation of a document, let alone postage based indicia being generated in parallel with the mail piece being created and processed. Further, as stated above, everything in *Freeman* is done in a serial fashion. *Freeman* clearly requires that the mail piece be printed, folded, inserted, etc. before it goes on to be weighed, and so forth. Thus, the creation of the document is accomplished long before postage begins to be calculated. It is further noted that the *Leon* Reference does not cure this deficiency. For at least the above reasons, the proposed combination fails to teach all of the limitations of claim 1. Accordingly, Applicant submits that the rejection should be withdrawn.

B. Rejection over *Freeman* in view of *Leon* and further in view of *Chang*

Claims 2 and 5-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* in further view of *Chang* et al. (U.S. Pat. 5,612,888, hereinafter “*Chang*”). Claims 2 and 5-6 depend directly from claim 1, and thus, inherit the limitations of their corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Further, neither *Leon* or *Chang* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claims 2 and 5-6 obvious.

Further, claim 2 recites “a quality control unit for monitoring the postage value calculated by the postage computing device.” The Office Action relies on *Chang* (col. 3 lines 10-14) to teach this limitation. This portion discusses an error handling task which maintains mail piece integrity in the event that the mailing system experiences a fault. A reading the rest of the *Chang* reference makes clear that the “faults” being monitored by the system are occurrences such as mechanical failure, out of paper, etc. Nothing in *Chang*, teaches performing quality control monitoring of a postage value that is calculated by a computing device.

The Office Action further states that “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art...if the prior art structure is capable of performing the intended use, then it meets the claim” (emphasis added). While Applicant disagrees that the claim merely recites intended use, Applicant notes that the Office Action never asserts, nor does it indicate any teaching in *Chang*, that the error handling task discussed can, in fact, monitor the postage value calculated by the postage computing device. Further, as shown above, there is no quality control structure in *Chang* which functions to monitoring the postage value calculated by the postage computing device. Applicant also notes that the claim has been amended, without changing its scope, to clarify the limitations contained therein. Therefore, Applicant submits that the rejection should be withdrawn.

C. Rejection over *Freeman* in view of *Leon* in further view of *Freeman 2*

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* in further view of *Freeman et al.* (U.S. Patent 6,041,569, hereinafter “*Freeman 2*”). Claim 7 depends directly from claim 1, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Further, neither *Leon* or *Freeman 2* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 7 obvious.

D. Rejection over *Freeman* in view of *Leon* in further view of *Ryan*

Claims 3-4 and 9-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Freeman* in view of *Leon* in further view of *Ryan, Jr.* (U.S. Patent 6,173,274, hereinafter “*Ryan*”). Claims 3-4 and 9-10 depend either directly or indirectly from claim 1, and thus, inherit the limitations of their corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 1. Additionally, neither *Leon* or *Ryan* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claims 3-4 and 9-10 obvious.

Further, claim 4 recites “wherein the mail processing components include a folder and an inserter.” The Office Action admits that *Freeman* does not teach these limitations and relies on *Ryan* to remedy this problem. Applicant respectfully submits that the Office Action fails to address the limitations of this claim in the context of the independent claim. Since the folder and inserter are “mail processing components,” they are physically processing the mail piece *in parallel* with the generation of the information based postage indicia. The indicia of *Freeman* can not be generated until after the mail piece created, folded, inserted in the envelope, and placed on a scale. Thus, adding the teachings of *Ryan* would simply add more steps in an already serialized process. In other words, the proposed combination does not create the claimed invention because merely adding a folder and inserter on the front end of *Freeman*, and maintaining the functionality of *freeman*, would not produce a system which generates an information based postage in parallel with the individual mail piece being physically created and processed by at least one of a folder and an inserter. Therefore, the proposed combination is not proper and does not render claim 4 obvious. *See, In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) (the prior art can not be modified or combined to reject claims if there is no reasonable expectation of success).

E. Rejection over *Ryan* in view of *Freeman* in further view of *Leon*

Claims 11-12, 15-16, and 18 are rejected under 35 U.S.C. § 103(a) as being anticipated by *Ryan* in view of *Freeman* in further view of *Leon*. In order for a combination of references to render a claim obvious, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combination fails to teach all of the claim limitations of independent claim 11, Applicant respectfully requests that the present rejection be withdrawn.

Claim 11 recites “generating an information based postage indicia, using said calculated postage value, for an individual mail piece of said each mail piece of said mail pieces in parallel with the individual mail piece being physically processed by one or more of the components, including at least one of a folder and an inserter, of said high-speed mail processing system.” The Office Action admits that *Ryan* does not teach these limitations and relies on *Freeman* to remedy the issue. However, as shown above when discussing the claim 1, *Freeman* teaches a

device that feeds a mail piece to a weighing module. After weighing the mail piece, the postage meter is set and the mail piece is then transferred through the metering system. (see *Freeman* Abstract). It is clear that everything in this process is done in serial. Accordingly, *Freeman* does not teach a device operable to generate information based postage indicia for an individual mail piece in parallel with the mail piece being physically processed.

Further, claim 11 requires that the postage based indicia is generated in parallel when the mail piece is being physically processed by one or more of the components including at least one of a folder and inserter. This is clearly not taught by *Freeman*. Examiner points to col. 9 lines 33-40 as teaching this limitation, but the cited portions do not discuss a folder, inserter, or using such in a parallel process. Additionally, any combination using *Ryan* and *Leon* does also fails teach this aspect. For at least the above reasons, *Freeman* fails to teach all of the limitations of claim 1. Accordingly, Applicant submits that the rejection is overcome.

Claims 12, 15-16, and 18 depend either directly or indirectly from independent claim 11, and thus, inherit each and every limitation of independent claim 11. As a result, claims 12, 15-16, and 18 are allowable for at least the reasons set forth above. Further, dependent claims 12, 15-16, and 18 contain aspects that are patentable in their own right.

F. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Manduley*

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and *Manduley* et al (U.S. Patent 5,079,714, hereinafter “*Manduley*”). Claim 14 depends either directly from claim 11, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 11. Further, neither *Leon* or *Manduley* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 14 obvious.

G. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Chang*

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and *Chang*. Claim 17 depends either directly from claim 11, and thus, inherits the limitations of its corresponding independent claim. As shown above, the *Freeman* reference fails to teach all of the limitations of claim 11. Further, neither *Leon* or *Chang* is not relied on to remedy these deficiencies. Therefore, the proposed combination, even if proper, fails to render claim 17 obvious.

H. Rejection over *Ryan* in view of *Freeman* in view of *Leon* and *Rasmussen*

Claim 19 is rejected under 35 U.S.C. § 103 as being anticipated by *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen* et al. (U.S. Pat. Pub. 2004/0088267, hereinafter “*Rasmussen*”). Claim 19 recites “said postage value calculated without weighing the individual mail piece, using information from said processing instructions, and is implemented in parallel with the high-speed processing of said mail piece.” Applicant respectfully submits that nothing in the cited art teaches using processing instructions to calculate postage without weighing the individual mail piece in parallel with the controlling the high-speed processing of the mail piece. Additionally, as shown above, a combination of *Freeman*, *Ryan*, and *Leon* does not create a system having such parallel capabilities. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

I. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen* and Official Notice

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen* and Official Notice. Claim 20 depends from claim 19, and thus, inherits the limitations of its corresponding independent claim. As shown above, the proposed combination fails to teach all of the limitations of claim 19. Therefore, the proposed combination, even if proper, fails to render claim 20 obvious.

In the previous response, Applicant asserted that the Office Action’s taking of official notice is improper. The Office Action asserts that “a high-speed printer capable of printing the postage value at any position or orientation on the email pieces is old and well known” (*see*

Office Action pg 11). Generally, mailing systems must singulate the pieces and orient them so as to align with the postage printer. It is noted that the *Freeman* reference singulates the mail pieces and uses a printer that requires mail pieces oriented prior to printing. (See *Freeman* abstract, Fig. 1). Additionally, the system taught in *Ryan* illustrates that the mail pieces are oriented, thereby not needing a printer of the type recited in claim 20. (See *Ryan* Fig 1). In fact, six different references have been applied in the present action, and none of them contemplate what is being asserted as well known. Accordingly, in the previous response Applicant requested documentation pursuant to M.P.E.P. 2144.03 showing a printer in a high-speed mail processing system capable of printing the postage value at any position or orientation on the mail pieces. Applicant notes that Examiner has not produced such documentation. Therefore, Applicant respectfully requests that the rejection be withdrawn.

J. Rejection over *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen*

Claim 22 is rejected under 35 U.S.C. § 103(a) as being anticipated by *Ryan* in view of *Freeman* in further view of *Leon* and *Rasmussen*. Claim 22 depends from claim 19, and thus, inherits the limitations of its corresponding independent claim. As shown above, the proposed combination fails to teach all of the limitations of claim 19. Therefore, the proposed combination, even if proper, fails to render claim 22 obvious.

IV. Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance, and respectfully requests favorable reconsideration.

Applicant believes no fee is due with this response. However, if any additional fee is due, or at any time during the pendency of this application, please charge any additional fees required or credit any overpayment to Deposit Account No. 02-2380, under Order No. 61135/P019US/10303184, from which the undersigned is authorized to draw.

Dated: August 18, 2008

Respectfully submitted,

By 

R. Ross Viguet
Registration No.: 42,203
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8185
(214) 855-8200 (Fax)
Attorney for Applicant